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REMARKS

Claim 1 has been amended by incorporating the recitations of claim 8, absent the metal oxide filler, therein. Claims 8 and 11 have thereby been cancelled. Entry of the above amendments is respectfully requested.

Review and reconsideration on the merits are requested.

Claims 1, 8, 9, 11, 17 and 18 have been rejected under 35 USC §102(b) as anticipated by, or in the alternative, under 35 USC §103 as obvious over Kitajima, et al. In response, Applicants traverse the rejection.

Kitajima, et al. does not teach an adhesive which bonds a first member and a second member as claimed in the present application. Instead, Kitajima, et al. teaches electrodes and methods for preparing them, wherein a conductive metal is used as a layer. A binder can be used in combination with this layer. One of the binders taught at col. 10, lines 2-6 includes an alcohol-soluble polyamide. However, the references do not teach or suggest that an alcohol-soluble polyamide can be used as an adhesive to bond a first and second member as claimed. Instead, the alcohol-soluble polyamide is taught as being a binder used in combination to form the electrode layer. In fact, the reference does not teach or suggest any adhesives. Instead, the layers are formed by vacuum-deposition, electro-plating and chemical plating (col. 9, lines 44-46, and col. 10, lines 40-41) with no adhesives.

Because Kitajima, et al. does not teach or suggest an adhesive material to bind a first member and a second member, Applicants submit that the present claims are not anticipated by the reference. In addition, Applicants submit that one of ordinary skill in the art looking to form an adhesive to bind a first member and a second member, would not have been motivated to use an alcohol-soluble polyamide taught by Kitajima, et al., as a binder in a metal layer. Therefore, Applicants further submit that the present claims are not rendered obvious in view of the cited reference. Accordingly, Applicants request withdrawal of the rejection of claims 1, 8, 9, 11, 17 and 18 under 35 USC §102(b) as anticipated by, or in the alternative, under 35 USC §103 as obvious over Kitajima, et al.

Claims 1, 8-12, 15, 17 and 18 have been rejected under 35 USC §103 as obvious over Kitajima, et al. in view of Yazami, et al. or Ito, et al. In response, Applicants traverse the rejection.

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Kitajima, et al. as been discussed above. Kitajima, et al. does not teach or suggest any adhesive bonding a first and second member as claimed. Applicants submit that the secondary references do not teach the deficiencies of the primary reference.

Yazami, et al. teaches carbons containing fluorine, methods of preparation thereof, and use as an electrode material. There is no teaching or suggestion in the reference to use the fillers set forth therein in combination with an adhesive.

Similarly, Ito, et al. teaches binders for porous electrodes. The reference teaches conductive fine particles that can be used with electrodes. As with Yazami, et al., Ito does not teach or suggest use of the disclosed fillers in combination with an adhesive.

Therefore, because neither of the secondary references teach or suggest use of conductive fillers in combination with an alcohol-soluble polyamide as taught by Kitajima, et al., and instead, merely teach conductive fillers that can be used with an electrode, Applicants submit that one of ordinary skill in the art would not have been motivated to combine the fillers taught by the secondary references with an alcohol-soluble polyamide as taught by Kitajima, et al. In addition, because none of the three references cited teach or suggest an alcohol-soluble polyamide adhesive to bind two members, Applicants submit that there would have been no motivation to use the alcohol-soluble polyamide taught by Kitajima, et al. as an adhesive, and further, there would have been no motivation to add the fillers of Yazami, et al. or Ito, et al., to an alcohol-soluble polyamide material, and then use that as an adhesive.

In view of the above, Applicants submit that the rejected claims are not obvious in view of the cited combination. Accordingly, Applicants request withdrawal of the rejection of claims 1, 8-12, 15, 17 and 18 under 35 USC §103 as obvious over Kitajima, et al. in view of Yazami, et al. or Ito, et al.

Claims 1, 3-6, 8, 9, 11, 15, 17, 18 and 20 have been rejected under 35 USC §103 as obvious over Kitajima, et al. in view of Nakamura, et al. or Kamosaki, et al. In response, Applicants traverse the rejection.

As set forth above, Kitajima, et al. does not teach or suggest an adhesive to bind a first and second member. Instead, Kitajima, et al. teaches an alcohol-soluble binder used in a layer for an electrode. Applicants submit that the secondary references do not teach the deficiencies of the primary reference.

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Nakamura, et al. teaches a photoreceptor. As the subbing layer which may have an adhesive function, an alcohol-soluble amide or a polyamide, is taught by the reference. However, there is no teaching or suggestion to combine a filler with the alcohol-soluble adhesive.

Applicants submit that one of ordinary skill in the art would not have been motivated to combine Kitajima, et al. and Nakamura, et al. for several reasons. First, Nakamura, et al. relates to a photoreceptor used in an electrophotographic apparatus. On the other hand, Kitajima, et al., relates to electrodes. Applicants submit that one of ordinary skill in the art would not have been motivated to combine the teachings of a reference related to a photoreceptor with the teachings of a reference related to electrodes. The references are not in the same field of endeavor. Secondly, Kitajima, et al., does not teach or suggest an adhesive as claimed or as taught by Nakamura, et al. Therefore, Applicants submit that one of ordinary skill in the art would not have been motivated to combine the teachings of Nakamura, et al. related to an adhesive, with the teachings of Kitajima, et al. related to a binder used in an electrode layer. Accordingly, Applicants submit that one of ordinary skill in the art would not have been motivated to combine the references cited.

Kamosaki, et al. relates to nylon coating compositions. As with Nakamura, et al. Kamosaki, et al. relates to finishing agents or adhesives. Also as with Nakamura, et al., Kamosaki, et al. does not teach or suggest use of a filler in combination with the adhesive material. Applicants submit that one of ordinary skill in the art would not have been motivated to combine the teachings of Kamosaki, et al. with Kitajima, et al. First, Kamosaki, et al. relates to an adhesive material, whereas Kitajima, et al. does not relate to an adhesive, but instead relates to a binder used in an electrode layer. In addition, Kamosaki, et al. relates to nylon coating compositions, whereas, whereas Kitajima, et al. relates to electrodes. The references are not in the same field of endeavor. Applicants submit that one of ordinary skill in the art would not have been motivated to combine the references because of such diverse teachings of the two references. Accordingly, applicants submit that one of ordinary skill would not have been motivated to combine the teachings of Kamosaki, et al. with Kitajima, et al.

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In view of the above, Applicants submit that the present claims are not rendered obvious in view of the cited combination. Accordingly, Applicants request withdrawal of the rejection of claims 1, 3-6, 8, 9, 11, 15, 17, 18 and 20 under 35 USC §103 as obvious over Kitajima, et al. in view of Nakamura, et al. or Kamosaki, et al.

Claims 1, 3-6, 8, 9, 11, 13, 17, 18 and 20 have been rejected under 35 USC §103 as obvious over Jung, et al. in view of Nakamura, et al. and/or Kitajima, et al. In response, Applicants traverse the rejection.

As set forth in previous amendments, Jung, et al. does not teach or suggest use of an alcohol-soluble polyamide as an adhesive. In addition, Jung, et al. teaches that the adhesive material disclosed therein can comprise epoxy, polythiophene, acylate, phenol-formaldehyde, polyamide, and combinations thereof. Therefore, the polyamide material is taught in a laundry list of other materials that can be used as the base for the adhesive. Therefore, Applicants submit that it would not have been obvious to pick polyamide out of the long laundry list of possible adhesive materials taught by Jung, et al. Obvious to try is not a valid rejection. In addition, there would have been no motivation to change the polyamide into an alcohol-soluble polyamide as claimed.

The Examiner relies on Nakamura, et al. and Kitajima, et al. as teaching alcohol-soluble polyamides. Applicants submit that one of ordinary skill in the art would not have been motivated to combine Nakamura, et al. with Jung, et al. Jung, et al. relates to electrode materials, whereas Nakamura, et al. relates to photoreceptor members used in the electrophotographic apparatuses. The references are not in the same field of endeavor. Applicants submit that one of ordinary skill in the art would not have been motivated to combine such diverse teachings of the two references. In addition, Nakamura, et al. does not teach or suggest use of a filler in combination with an alcohol-soluble polyamide. Accordingly, Applicants submit that one of ordinary skill in the art would not have been motivated to combine the two references.

Applicants further submit that one of ordinary skill in the art would not have been motivated to combine the teachings of Kitajima, et al. with that of Jung, et al. and/or Nakamura, et al. Kitajima, et al. does not even relate to an adhesive material. Nakamura, et al. and Jung, et al. both teach adhesive materials. Therefore, Applicants submit that one of ordinary skill in the art would not have been motivated to combine the teachings of

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two references teaching adhesive materials with a reference that does not teach adhesive materials. In addition, Kitajima, et al. relates to electrodes, whereas Nakamura, et al. relates to a photoreceptor member used in an electrophotographic apparatus. Therefore, Applicants submit that one of ordinary skill in the art would not have been motivated to combine the teachings of Kitajima, et al. with Nakamura, et al. because of the diverse disclosures. Further, Jung, et al. teaches an adhesive material that can be used with electrodes, whereas Kitajima, et al. does not. Instead, Kitajima, et al. relates to a binder that can be used in an electrode metal layer. Therefore, Applicants submit that one of ordinary skill in the art would not have been motivated to combine Jung, et al. with Kitajima, et al.

In view of the above, Applicants submit that the present claims are not obvious in view of the cited combination. Accordingly, Applicants request withdrawal of the rejection of claims 1, 3-6, 8, 9, 11, 13, 17, 18 and 20 under 35 USC §103 as obvious over Jung, et al. in view of Nakamura, et al. and/or Kitajima, et al.

Claims 1, 3-6, 8, 11, 17, 18 and 20 have been rejected under 35 USC §102 as anticipated or, in the alternative, under 35 USC §103 as obvious over Katayama, et al. In response, Applicants traverse the rejection.

The present claims have been amended by incorporating the recitations of claim 8 therein. Applicants submit that Katayama, et al. does not teach or suggest the elements of the currently amended claims.

Katayama, et al. teaches a photoreceptor comprising an undercoating layer on a conductive support. On top of the undercoating layer is a photoreceptive layer. The undercoating layer comprises titanium dioxide coated with a surface of metal oxides and/or an organic compound which can be an alcohol-soluble polyamide resin. Therefore, although the reference teaches an alcohol-soluble polyamide in combination with a metal oxide filler as an adhesive, the reference does not teach or suggest the claimed alcohol-soluble polyamide in combination with electrically conductive fillers selected from the group consisting of carbon fillers, polymer fillers, charge transporting molecules, and mixtures thereof, as an adhesive layer to bind two layers together. Because Katayama, et al. does not teach or suggest all the elements of the present claims, Applicants submit that the present claims are not anticipated by the reference.

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In addition, Applicants submit that the present claims are not rendered obvious in view of the cited reference. Applicants submit that one of ordinary skill in the art would not have been motivated to use the claimed fillers in combination with an alcohol-soluble polyamide as an adhesive, in view of the teachings of Katayama, et al. Katayama, et al. teaches use of metal oxides in combination with a polyamide adhesive. In column 12, the reference lists the metal oxides as aluminum oxide, zirconium oxide, or mixtures thereof. There is no teaching or suggestion that a conductive filler such as the claimed carbon fillers, polymer fillers, charge transporting molecules or mixtures thereof, can be used in combination with a alcohol-soluble polyamide as claimed. Therefore, because Katayama, et al. merely teaches use of a metal oxide in combination with an alcohol-soluble polyamide, and because there is no teaching or suggestion in the reference to modify the metal oxide into one of the claimed electrically conductive fillers such as a carbon filler, polymer filler, charge transporting molecule or mixture thereof, Applicants submit that one of ordinary skill in the art would not have been motivated to make such a drastic change. Accordingly, Applicants submit that the present claims are not rendered obvious in view of the reference, and request withdrawal of the rejection of claims 1, 3-6, 8, 11, 17, 18 and 20 under 35 USC §102 as anticipated or, in the alternative, under 35 USC §103 as obvious over Katayama, et al.

Applicants appreciate the Examiner's indication that claims 14 and 16 contain allowable subject matter.

Applicants appreciate the Examiner's indication that claim 21 is allowed.


In view of the above arguments, Applicants submit that all claims should now be in condition for allowance. Early indication of allowability is respectfully requested.

No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation Attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

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In the event the Examiner considers personal contact advantageous to the disposition of this case, s/he is hereby authorized to call Applicant's Attorney, Annette L. Bade, at telephone number (310) 333-3682, El Segundo, California.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'Annette L. Bade', is written over a horizontal line. The signature is fluid and cursive.

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